

Response under 37 CFR 1.116  
Expedited Procedure  
Examining Group 3600  
Application No. 09/228,566  
Paper Dated November 2, 2005  
In Reply to USPTO Correspondence of August 24, 2005  
Attorney Docket No. 1692-011111

### REMARKS

Applicant thanks the Examiner for the courtesies extended in the telephone interview, conducted on November 1, 2005.

Claims 1, 2 and 5 are pending in the instant application. Claims 1, 2 and 5, however, remain rejected Under 35 U.S.C. § 103(a) as obvious over Japanese Patent No. 2-14921 ("JP '921") in view of German Patent No. 743530 ("DE '530"), or Falk and further in view of Japanese Patent No. 411020723 A ("JP '723").

As discussed during the interview, the Examiner expresses the "problem" to be solved by the instant invention as seeking to non-rotatably fix a body to a rotating shaft and then allow uncoupling of said components. (See p. 7, first full paragraph of the outstanding Office Action.) Applicant respectfully submits that this is a mischaracterization of the problem to be solved by the instant invention. Particularly, the instant application clearly states that the problem being addressed by the inventor was to make it easier to adjust backlash between a worm and a worm wheel in a dividing head using a multiple lead type worm. (See instant Specification, p. 2, 3<sup>rd</sup> Para.) The Examiner, to support the proposed combination of the Falk and DE '530 references, has redefined the inventor's problem in terms of its solution. Neither Falk nor DE '530 has anything remotely to do with adjusting backlash in a dividing head using a multiple lead type worm. The Federal Circuit has said that this type of redefinition of the problem, to support obviousness, is improper. See *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F. 3d 877, 881, 45 U.S.P.Q. 2d 1977 (Fed. Cir 1998). (Copy of p. \*881 attached.)

This case is not unlike *In re Oetiker*, 977 F. 2d 1443 (Fed. Cir 1992), (discussed at MPEP § 2141.01(a) (IV)). There, the examiner had cited a fastener for a garment, against a claimed fastener for a hose clamp. The Commissioner had argued that a disengageable catch was a common mechanical concept. But the Court held that the cited reference was not in the field of the applicant's endeavor, and someone attempting to solve the problem of fastening a hose clamp would not be expected to look to fasteners for garments.

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Applicant has further amended the instant claims to highlight the problem being solved by the instant invention. Particularly, the claims are now in Jepson format, and the preamble, as well as the last paragraph in the body of the claim, sets forth that the invention is directed to the problem of facilitating the adjustment of backlash in a dividing head using a multiple lead type worm.


While it is in relation to worm gears, the JP '723 reference teaches away from the instant invention, by showing the worm gear integrally forged with the shaft, rather than separate as in the instant invention. Furthermore, like DE '530 and Falk, JP '723 is not directed at all to the problem of adjusting backlash in dividing heads using a multiple lead type worm. JP '723 is thus not properly combined with JP '921, Falk or DE '560 as a basis for an obviousness rejection of the invention as now specifically claimed.

In light of the above amendments and remarks, claim 1 (and dependent claims 2 and 5) are now deemed allowable.

Respectfully submitted,

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139 F.3d 877, \*; 1998 U.S. App. LEXIS 4165, \*\*;  
45 U.S.P.Q.2D (DNA) 1977

This court concludes that genuine issues of material fact remain. Although Groz-Beckert later supplemented the record with additional evidence of objective indicia of nonobviousness, this evidence was not before the trial court for the first motion for summary judgment. Except as otherwise stated, this court relies only on the evidence available to the district court when it entered summary judgment on claim 1. Thus, this court's conclusion necessarily follows for all the claims at issue, regardless of the fact that the district court invalidated all other claims in a second motion on a supplemented record.

## II.

This court reviews a district court's grant of summary judgment de novo by reapplying the standard applicable at the district court. See *Conroy v. Reebok Int'l, Ltd.*, 14 F.3d 1570, 1575, 29 U.S.P.Q.2D (BNA) 1373, 1377 (Fed. Cir. 1994). Summary judgment is appropriate only when "there is no genuine issue as to any material fact and . . . the moving party is entitled to a judgment as a matter of law." Fed. R. Civ. P. 56(c). [\*\*8] In its review, this court draws all reasonable inferences in favor of the nonmovant. See *United States v. Diebold, Inc.*, 369 U.S. 654, 655, 8 L. Ed. 2d 176, 82 S. Ct. 993 (1962). Moreover, in rendering a decision on a motion for summary judgment, a court must "view the evidence presented through the prism of the substantive evidentiary burden" that would [\*\*81] inhere at trial. See *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 254, 91 L. Ed. 2d 202, 106 S. Ct. 2505 (1986). The moving party "bears the burden of demonstrating the absence of genuine issues of material fact." *Conroy*, 14 F.3d at 1575.

In this case, the district court rendered summary judgment on the question of obviousness. Obviousness is ultimately a determination of law based on underlying determinations of fact. See *Richardson-Vicks Inc. v. Upjohn Co.*, 122 F.3d 1476, 1479, 44 U.S.P.Q.2D (BNA) 1181, 1183 (Fed. Cir. 1997). These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness. See *Graham v. John* [\*\*9] *Daara Co.*, 383 U.S. 1, 17-18, 15 L. Ed. 2d 145, 86 S. Ct. 684 (1966). Thus, to review a summary judgment of obviousness, this court first determines anew whether the record raises any genuine issues about these critical facts. In doing so, this court remains cognizant of the statutory presumption of validity, see 35 U.S.C. § 282 (1994), and of the movant's burden to show invalidity of an issued patent by clear and convincing evidence, see *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 716, 21 U.S.P.Q.2D (BNA) 1053, 1055 (Fed. Cir. 1991). If facts remain in dispute, this court weighs the materiality of the dispute, i.e., whether resolution of the dispute one way or the

other makes a difference to the final determination of obviousness.

Given the occasional use of archaic terminology in the district court's opinion, this court also emphasizes that the standard for patentability is the statutory standard. The inquiry is not whether there was a "real discovery of merit" or whether the claimed invention offered a "new solution," but whether the claimed subject matter as a whole "would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 [\*\*10] U.S.C. § 103(a) (Supp. I 1995).

## III.

To ascertain the scope of the prior art, a court examines "the field of the inventor's endeavor," *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 620, 225 U.S.P.Q. (BNA) 634, 638 (Fed. Cir. 1985), and "the particular problem with which the inventor was involved," *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1535, 218 U.S.P.Q. (BNA) 871, 876 (Fed. Cir. 1983) (quoting *In re Wood*, 599 F.2d 1033, 1036, 202 U.S.P.Q. (BNA) 171, 174 (CCPA 1979)), at the "time the invention was made," see 35 U.S.C. § 103(a). The district court defined the problem as "designing the stem segment of a knitting needle . . . [to] minimize[] needle head breakage and thus maximize[] the operating speed of an industrial knitting machine." (emphasis added). The '053 patent, on the other hand, describes the inventor's problem as "providing [knitting needles] with a means which avoids head breakages or lots [breakages] start to an extent worth mentioning only at higher knitting speeds." '053 patent, col. 1, lines 48-51. The district court's formulation of the problem confronting the '053 inventor presumes the solution to the problem - modification [\*\*11] of the stem segment. Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness. See, e.g., *In re Anile*, 58 C.C.P.A. 1382, 444 F.2d 1169, 1171-72, 170 U.S.P.Q. (BNA) 285, 287-88 (CCPA 1971) (warning against selection of prior art with hindsight). By importing the ultimate solution into the problem facing the inventor, the district court adopted an overly narrow view of the scope of the prior art. It also infected the district court's determinations about the content of the prior art.

The district court based its conclusion of obviousness heavily on its determination that the prior art showed a "trend" towards increasingly lower stem segment heights. A "trend" might very well constitute a suggestion or teaching to one of ordinary skill in the art to make "minor" changes from the prior art in accordance with that trend to produce the claimed invention. Cf. *In re Chu*, 66 F.3d 292, 298, 36 U.S.P.Q.2D (BNA) 1089, 1094 (Fed. Cir. 1995) (stating that even when changes